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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CAPUTO, LISA M

ART UNIT PAPER NUMBER

2876

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,514

Applicant(s)

MILLER ET AL.

Examiner

Lisa M. Caputo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 7-29 is/are allowed.
- 6) ☒ Claim(s) 4-6 and 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/05:5/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed 13 April 2005.

Terminal Disclaimer

2. The terminal disclaimer filed on 13 April 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 4-5, 30-31, and 33 are rejected under 35 U.S.C. 102(a) as being anticipated by Monico (U.S. Patent No. 6,021,942).

Monico teaches a bar-coded label for "attempt to deliver" parcels. Monico discloses an exemplary business form according to the present invention is shown generally by reference numeral 10 in FIGS. 1-4. The form 10 comprises a sheet 11 of imagable material, typically paper, having top and bottom edges 12, 13 and first and second side edges 14, 15, a front face 16 (see FIG. 1), and a rear face 17 (see FIG. 2). Preferably the form is quadrate in configuration as illustrated in the drawings, the edges 12, 13 being substantially parallel to each other and substantially perpendicular to the edges 14, 15 (which edges 14, 15 are substantially parallel to each other). The form 10

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also comprises one or more (e.g. at least two) lines of weakness, such as the two lines of weakness 18, 19 in the drawings. The lines of weakness 18, 19 may be any conventional lines of weakness such as score lines, crease lines, diecuts, or the like, but preferably are perforations as illustrated in the drawings. The lines 18, 19 are preferably substantially parallel to one or both of the edges 12, 13, and define the form 10 into various sections, including at least two sections. In the embodiment illustrated in the drawings the sheet 11 is divided into three sections, a first section 21, a second section 22, and a third section 23, although more than three sections may be provided (and perforations or like lines of weakness parallel to the edges 14, 15 may also or alternatively be utilized), or two sections may be provided in some circumstances. Part or all of the face 17 is covered with pressure sensitive adhesive. FIG. 2 illustrates three different repositional adhesive strips, blocks, or other patterns, 24, 25, and 26 associated with the sections 21-23, respectively. All three blocks or patterns of repositional adhesive 24-26 may be the same adhesive, applied continuously to the entire face 17. Preferably the adhesive blocks or patterns 25, 26 are repositional adhesive (such as "CLEANTAC" adhesive available from Moore U.S.A., Inc. of Lake Forest, Ill.) of any conventional type, and preferably the adhesive 24 is also repositional adhesive, although it may be permanent adhesive or removable adhesive in some circumstances. A conventional release liner 28 (see FIGS. 2-4) is preferably provided covering the adhesive 25 in the second section 22 of rear face 17. The release liner 28 is of any conventional release liner material, such as silicone coated paper. The purpose of the release liner 28 is to protect the adhesive 25 even when the third section

23 has been removed and the first section 21 is adhered to a package (as will be further described). While in the preferred embodiment--which includes providing the business form 10 in a pad or like form, such as the pad 29 illustrated in FIG. 3--if the forms 10 are provided as individual sheets preferably a release liner is provided to cover up the adhesive 24, 26 in the sections 21, 23 also. FIG. 3 illustrates a pad 29 of business forms 10 according to the invention. Typically all of the forms in the pad 10 are identical except for identification indicia thereon. The pad 29 includes a backing, which may be of paper (including paper having a release coating), cardboard, or the like, 30. The repositionable adhesive on each of the sections 21, 23 engages the repositionable adhesive on the like, underlying form 10, and since the adhesive is repositionable each form will readily separate from the others. If desired one or more portions of each of the forms 10--such as the corner portion 31 illustrated in FIG. 2--may be devoid of adhesive so as to facilitate easy removal of the forms 10 from the pad 29. If the adhesives 24, 26 utilized for the forms 10 in the pad 29 are particularly aggressive, or are not repositionable, it may be desirable to coat the front face 16 of each of the forms 10 with a release coating, such as silicone. If the forms 10 include release liners covering all of the sections 21-23, then the forms 10 may either be individual sheets, or if connected in a pad may have conventional binding materials joining all of the forms 10 at the top edges 12 thereof, to each other and to a backing 30. The forms 10 also have indicia imaged on the front face 16 thereof, and the particular indicia utilized according to the invention greatly facilitates utilization of the forms 10 for package delivery functions. Preferred indicia utilized according to the invention is best seen in FIG. 1. The first section 21

typically includes identification indicia shown generally by reference 33 in FIG. 1, and including a machine-readable (e.g. bar code) part 34, and a human-readable part 35. The first section 21 also comprises a plurality of (at least two, and preferably at least three) reason for non-delivery indicia. These indicia all include a machine-readable (e.g. bar code) part 36 and a corresponding human-readable part 37. The particular reason for non-delivery indicia illustrated in FIG. 1 include "wrong address", "consignee moved", "consignee not at home", "office closed", "damaged", "refused delivery", "not delivered (no time)", "wrong route", and "other". The "other" indicia is followed by lines 38 facilitating the entry of handwritten information. The above reasons for non-delivery are exemplary only and different or other wording and/or reasons may be provided. The third section 23, which may be connected directly to the first section 21 if the second section 22 is not provided, preferably includes indicia 133 in common with the indicia 33 (except having an extender indicating the first attempt at delivery). This includes a machine-readable part 134 and a human-readable part 135, with the extenders 40, 41. The indicia imaged on the third section 23 also preferably includes human-readable indicia 42 (e.g. "first attempt") indicating a first attempt to deliver a package, and preferably also includes a toll-free telephone number indicia 43 to call if an indicated redelivery time is inconvenient, to request redelivery, and/or for questions, and one or more blank areas 44 for the entry of handwritten indicia indicating potential other delivery dates or times. Also there may be indicia 45 indicating that if the addressee/consignee would like the package merely left at the door that he or she can sign at the indicia 46 and on the next delivery the package will merely be left at the

door. Other suitable indicia also may be provided, as illustrated in the example in FIG.

1. The second section 22 also includes identification indicia 233, but with a different extender 240, 241, the indicia 233--except for the extender--in common with the indicia 33, 133. Attempted delivery indicia ("second attempt") 48 also is provided, as well as the toll-free telephone number 43, and any other suitable notification indicia, such as the indicia 49 illustrated in FIG. 1. If multiple attempts will be made by the courier delivery service, the second section 22 may be substantially identical to the first section 23 (except for the extenders 240, 241 and the indicia 48) and other sections for third or subsequent attempts may also be provided. The business forms 10 according to the present invention facilitate the practice of a method of accurately delivering packages, with automated entry into a database of a wide variety of information being provided. An exemplary method according to the present invention will be described most particularly with respect to FIG. 4. A courier or delivery service driver unsuccessfully attempts to deliver a package 51 to an addressee/consignee, the address 52 (as well as typically return address 53) being provided on the package 51. When the attempt is known to be unsuccessful, the driver scans one of the machine-readable indicia elements 36 (corresponding to the correct human-readable indicia 37) using a conventional scanner 54 of any type (i.e. handheld as recited in the instant application). Typically only one indicia element 36 can be scanned for a particular identification indicia 34, but under some circumstances programming may be provided to allow more than one reason for non-delivery to be scanned. The driver also scans in the I.D. number 34 of the form 10, both the I.D. number 34 and the reason for non-delivery 36 being transmitted to a

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suitable database in a computer 55 which may be in the driver's possession, or electronically connected in some conventional manner to the scanner 54 and at a central location. Hence, Monico teaches a method of altering the delivery of an item when an attempted delivery of the item by a delivery service has been unsuccessful and the intended recipient has been provided a delivery notice code, comprising contacting the delivery service, using the delivery notice code to access information about the item wherein the information includes delivery plans for the parcel and modifying the delivery plans based upon subsequent instructions from the recipient (see Figures 1-4, col 3 line 62 to col 6 line 59).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 6, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monico in view of Knowles et al. (U.S. Patent No. 5,869,819, from hereinafter "Knowles"). The teachings of Monico have been discussed above.

Monico fails to disclose that an Internet connection is used for receiving data.

Knowles teaches an internet-based system and method for tracking objects bearing URL-encoded bar code symbols. Knowles discloses a novel Web-based package routing, tracking and delivering system and method that uses URL/ZIP-CODE encoded bar code symbols on parcels and packages. The system comprises one or more Routing, Tracking and Delivery (RTD) Internet Server Subsystems connected to the Internet infrastructure and updated at any instant of time with package tracking information. A Package Log-In/Shipping Subsystem is located at each shipping location and connected to the RTD Internet Server by way of the Internet infrastructure. A Package Routing Subsystem is located at a hub station and connected to the RTD Internet Server by way of the Internet infrastructure. A Portable Package Delivery Subsystem is carried by each package delivery person, and connected to the RTD Internet Server by way of the Internet infrastructure communication link. At each remote hub station within the system, the URL/ZIP-CODE encoded bar code symbol is automatically scanned by way of the Internet infrastructure; the encoded destination Zip Code is locally recovered and used to route the package at the hub station; and the locally recovered URL is used to access the RTD Internet Server and update the location of the package within the system. The Portable Package Delivery Subsystem is used to read the URL/ZIP-CODE encoded bar code symbol near the delivery

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destination in order to access the RTD Internet Server and display delivery information and the like to facilitate the delivery process (see abstract).

In view of the teaching of Knowles, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ an internet connection for transmitting data because it is well known in the art that the internet is a reliable, convenient, and safe way to transmit data.

Allowable Subject Matter

6. Claims 1-3 and 7-29 are allowed.
7. The following is an examiner's statement of reasons for allowance:

The best prior art of record fails to teach the specific system and method of linking delivery notice codes. The best prior art of Monico teaches the use of multiple delivery notices with the same delivery codes and Gulick teaches only that each item code is consolidated into one barcode for scanning, which does not teach the limitations of the present invention as recited in claims 1-3 and 7-29. Hence the best prior art of record fails to teach the invention as set forth in claims 1-3 and 7-29 and the examiner can find no teaching of the specific delivery system and method, nor reasons within the cited prior art or on her own to combine the elements of these references other than the applicant's own reasoning to fully encompass the current pending claims. In addition, see applicant's reasoning in amendment/response filed 13 April 2005.

Response to Arguments

8. Applicant's arguments with respect to claims 4-6 and 30-34 have been considered but are moot in view of the new ground(s) of rejection.

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9. Applicant's arguments, see response, filed 13 April 2005, with respect to claims 1-3 and 7-29 have been fully considered and are persuasive. The rejection of these claims has been withdrawn.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at **(571) 272-2398**. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [lisa.caputo@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


LMC

June 22, 2005


DIANE I. LEE
PRIMARY EXAMINER